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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,159	12/01/2003	Erning Xia	P03366	4792
23702 7590 02/25/2008 Bausch & Lomb Incorporated One Bausch & Lomb Place Rochester, NY 14604-2701				
EXAMINER				
BARHAM, BETHANY P				
ART UNIT		PAPER NUMBER		
1615				
MAIL DATE		DELIVERY MODE		
02/25/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/725,159

Applicant(s)

XIA ET AL.

Examiner

Bethany Barham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4.7.9-12.20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4.7.9-12.20 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Summary

Receipt of Applicant's Response and Amended Claims filed on 09/14/2007 is acknowledged. Claims 4, 7, 9-12 and 20-21 are pending. Claims 4, 7, 9-12, and 20-21 are rejected.

MAINTAINED REJECTIONS

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 7, 9-12, and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over US patent 6,274,133 ('133) in view of US patent 5,928,606 ('606). The limitations of claims 9-12 and 20-21 are taught by '133 in view of '606:

- '133 disclose a method for treating a contact lens with a solution (abstract). The method comprises contacting the surface of a contact lens with a solution comprising a cationic cellulose polymer, a tonicity agent, and a buffering agent (claim 1). Cellulose polymers are a well-known example of polysaccharides,

further polyquaternium 10 or UCARE polymers are taught by '133 (col. 5, lines 39-42).

- One or more surfactants are taught by '133 in claim 2. Viscosity agents such as PVP K30 are taught and Tetronic 1107 is a known surfactant (Table 2).
- According to '133, a wetting agent can be added to the contact lens solution (Claims 4-5). The wetting agent can comprise mono or disaccharides (claim 5). Thus, the contact lens solution advanced by '133 comprises a cationic polysaccharide and a saccharide.
- It should be noted that the examiner is interpreting a contact lens as a type of medical device.

The limitations of claims 4 and 7 are taught by '133 in view of '606:

- Table 2 and Example 2 teach including Polymer JR or Polymer JR 30M (col. 10, lines 19 and 39-40).
- '133 does not teach glucose or alpha-methyl glucopyranoside, but teaches saccharides generically.
- '606 teaches a device for cleaning and disinfecting a contact lens, and a method of disinfecting a contact lens comprising a wetting agent (abstract) and the wetting agents are taught to include saccharides such as glucose (col. 10, lines 36-52).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of '133 with '606, since both teach a method of treating a contact lens for disinfection. Further, '133 discloses a treatment composition

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comprising polysaccharides such as polyquaternium 10 and polymer JR 30M and tonicity and buffering agents along with wetting agents, one of ordinary skill in the art would be motivated to look to '606 for known wetting, tonicity and buffering agents used in contact lens treatment solutions and would find that glucose is a known wetting agent and imparts disinfecting and cleansing properties. As such it would have been prima facie obvious to combine the teachings of '133 and '606 to obtain a method of imparting preservative efficacy to contact lens and medical devices comprising polyquaternium 10 and saccharides such as glucose.

Response to Arguments

Applicant's arguments with respect to claims 4, 7, 9-12 and 20-21 have been considered but are not persuasive. Applicant has argued that not each and every limitation is taught by the prior art, but the Examiner respectfully disagrees. Applicant's argue that there is no prima facie case of obviousness and no motivation to combine '133 and '606, and the examiner respectfully points out that applicant's argue against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

It should be noted that the motivation to combine references can be different from the ones set forth by Applicant. That is, as long as motivation exists to combine the elements, the problem to be solved does not have to involve the same reason for

making the antimicrobial or antibacterial composition. As such, the examiner respectfully submits that there is motivation to combine the teachings of '133 in view of '606 and the expected result of treating a contact lens. '133 teaches a contact lens cleansing solution combining polyquaternium 10 with a wetting agent such as a mono- or di-saccharide while '606 teaches wetting agents such as glucose for treating and disinfecting contact lenses. As such a composition of '133 for treating contact lenses comprising polyquaternium 10 and glucose would cleanse and disinfect the lenses according to the prior art. Disinfectant is defined by the Columbia Encyclopedia as an "agent that destroys disease-causing microorganisms and their spores...[and] some disinfectants, especially chlorine and chlorine compounds, are also used as preservatives for leather and other materials" (<http://www.answers.com/topic/disinfectant>). Applicant argues that the references teach additional disinfectants such as biguanide, etc, however Applicant's claims recite the open 'comprising' language and do not exclude the addition of other components to the solution.

CITED AS INTEREST

Further, according to US Patent 6,916,958 (cited as interest) polymeric quaternary ammonium compounds such as polyquaternium are useful in disinfecting and preserving ophthalmic compositions/contact lenses and teach that the amount effective to preserve is overlapping with the amount effective to disinfect (col. 6, lines 5-29). As such it appears that Applicant is claiming a known characterization. Further,

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the prior art ('133 in view of '606) teaches a composition and process for treating contact lenses with said composition as described by applicants instant application, but applicants observation that it also has 'perservative efficacy' does not give it patentable weight, since it is the same composition and same process of treating to cleanse and disinfect, as adding a known characterization to a prior art patented invention is not patentable.

Conclusions

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bethany Barham whose telephone number is (571)272-6175. The examiner can normally be reached on M-F, 8:30 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bethany Barham/
Art Unit 1615

/Michael P Woodward/
Supervisory Patent Examiner, Art
Unit 1615